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EXAMINER

TM02/0111

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ART UNIT PAPER NUMBER

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Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No. 09/332,846	Applicant George W. Landry
Examiner RAQUEL ALVAREZ	Group Art Unit 2162

Responsive to communication(s) filed on Oct 24, 2000.

This action is FINAL.

Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

Claim(s) 25-88 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

Claim(s) 42-56 and 74-88 is/are allowed.

Claim(s) 25-41 and 57-73 is/are rejected.

Claim(s) _____ is/are objected to.

Claims _____ are subject to restriction or election requirement.

Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The drawing(s) filed on _____ is/are objected to by the Examiner.

The proposed drawing correction, filed on _____ is approved disapproved.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

All Some* None of the CERTIFIED copies of the priority documents have been

received.

received in Application No. (Series Code/Serial Number) _____.

received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

Notice of References Cited, PTO-892

Information Disclosure Statement(s), PTO-1449, Paper No(s). 8

Interview Summary, PTO-413

Notice of Draftsperson's Patent Drawing Review, PTO-948

Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

1. Claims 25-88 are presented for examination.
2. The terminal disclaimer to claims 25-88, overcame the double patenting rejection.
3. The arguments regarding the prior art used over claims 25-41 and 57-73 have been considered but are deemed not persuasive.

Claim Rejections - 35 U.S.C. § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:
 - (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.
5. Claims 25-33, 35-41 and 57-73 are rejected under 35 U.S.C. 102(b) as being anticipated by Knight et al. (5,383,113 hereinafter Knight) in view of Pickering(5,483,445 hereinafter Pickering).

- A. With respect to claims 25- 28, and 57-60, Knight discloses a bill payment system having storage for payee information(col. 3 lines 30-54), storage for payor information for each of a plurality of payors, the payor information for a payor identifying a plurality of payees authorized by the payor to receive transfer of funds from the payor(i.e. the payor(consumer) informs the

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service provider or processor of a payee's(merchant) name, address, phone number and the consumer's account number with the merchant. This information is stored into a merchant master file database)(col. 3, lines 3, lines 30-36), and control parameters defining the manner in which transfer of funds are to be performed(i.e. control and payment parameters established by the consumer)(col. 68 to col. 2, line 2).

Knight does not specifically teach: a payee communications interface receiving bill data from each of said payees. Nevertheless, Pickering discloses an automated bill paying system which serves a plurality of payors and a plurality of payees, Periodic electronic transfer of billing information from payees to the bill paying system(Abstract, lines 4-7) is disclosed. It would therefore have been obvious to one skilled in the art to add electronic transfer of bill data from payees to the bill paying system of Knight because it would relieve the consumers of the burden of transferring this information themselves and it would be more efficient than the payees transferring this information outside the system.

Pickering also teaches funds transfer interface generating one or more electronic funds transfer messages to the payee and the payor(col. 8, lines 1-23). It would have been obvious to a person of ordinary skill in the art at the time of applicant's invention to have sent a electronic transfer message to the consumer and the merchant of Knight because such a modification would confirm the transaction to the parties involved.

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B. As per claims 29 and 61, Knight further teaches that the interactive device comprises a telephone under the control of the payor, and said transactions are presented to a payor via the telephone(abstract and col. 3, lines 55-, col. 4, lines 1-28).

C. Claims 30 and 62 further recite that the transactions are presented to the payor via an automated teller machine(ATM). Knight teaches that the transactions are presented to the payor via telephone, computer terminal or other telecommunication means(abstract). Knight does not specifically teach an ATM. An ATM like the computer terminal and the telephone interface provides the customer with more choices to choose from.

D. With respect to claims 31-34 and 63-66, Knight further teaches that the transactions identify a date by which funds are to be transferred from a payor to a payee in payment of a bill(Figure 3 and col. col. 3, lines 30-54).

E. With respect to claim 35-37 and 67-69, Knight further teaches identifying the payee as the one originating a bill, identifying a payee by name)(col. 3, lines 55-, col. 4, lines 1-28). Knight does not specifically teach identifying a payee by an identifier. Official notice is taken that is old and well known to use identifier for bearing identifying information. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included using an payee identifier because such a modification would provide a more reliable identification process.

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F. With respect to claims 38 and 70, Knight further teaches presenting to the payor one or more functions, and the payor communication interface is responsive to a payor's selection of a function at the interactive device(Figure 3).

G. With respect to claims 40 and 72, the claims further recite: preventing transfer of funds which exceeds the maximum amount specified by the payor. Knight discloses the payors as setting the actual payment amounts. This teaches indirectly that a maximum amount is set when the payor sets that amount. The combination of Knight and Pickering differ from applicant's invention in that it does not specifically teach: preventing transferring of funds which exceeds the maximum amount specified by the payor. Nevertheless, it is well known in the computer related arts to have systems in which an error message is generated to let the user know that the system has encountered a problem and that it cannot proceed. Therefore it would have been obvious to a person of ordinary skill in the art at the time of applicant's invention to prevent transfer of funds, such as generating an error message, if the transactions did not meet predetermined criteria because it would give the user notification that the system has encountered an unapproved transaction and allow correction or investigation of the problem.

H. With respect to claims 41 and 73, the claims further recite: preventing a transfer of funds if any other transfer of funds for the payor and payee occurred during the minimum set time interval. Knight discloses payor-established time intervals between billings(col. 3, lines 44-45). This teaches indirectly that a minimum is set when the payor sets the time interval.

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6. Claims 34 and 71 are rejected under 35 U.S.C. 103(a) as being unpatentable over Knight, Pickering and further in view of Hilt et al.(5,465,206, Hilt hereinafter).

A. As per claims 34 and 71, the combination of Knight, Pickering differ from Applicant's invention in that it does not disclose that payors can send messages through the payor control interface which affect EFT transactions which reverse transfers which have been made due to payee-initiated modifications of the billing information. Hilt discloses an automated bill paying system serving a plurality of payees and a plurality of payors. Hilt, like Knight Pickering and addresses the problem of easing the burdens on the payor or payee of attending to numerous bills(Hilt, col. 1, lines 26-30). Hilt discloses payment reversal messages(col. 15, lines 29-38). Although the reversal message in Hilt is initiated by the bank or bill payment system rather than the payor, it does teach that reversal transactions are possible. It would have been obvious to a person of ordinary skill in the art to add a payor-initiated reversal option to the combination of Knight and Pickering in order to give the payors more control over their funds and the timing of payments and to allow correction of errors. The desirability of payor control is discussed in Hilt at col. 3, lines 32-34.

Allowable Subject Matter

7. Claims 42-56 and 74-88 allowed.

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The Examiner asserts that the date of the transfer for at least one bill being determined absent payor intervention based on at least one of bill data for the bill, stored payor information, without regard to due dates of bills of other payees, is not taught in the prior art of record.

A terminal disclaimer must be filed to overcome the double-patenting rejection.

Response to Amendment

A. The Knight reference describes three different manners by which the service provider may pay bills. It appeared to the Examiner that the Applicant had argued mostly the first manner in which the service provider may pay bills. Nevertheless, the Examiner's rejection was based on the third manner by which the service provider may pay bills.

B. In the Checkfree/Knight system, the method in which the service provider may pay bill is by writing a check on the service provider's account. The service provider is later reimbursed by the (consumer's) baking institution(s)(col. 6, lines 9-17). In this case Checkfree is the drawer, contractual party or payee of the draft. The Examiner wants to point out that if the prior art structure is capable of performing the intended use, then it meets the claim limitation. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

C. The Examiner disagrees with Applicant's statement on page 5 of the response to the office action which states that " a central purpose of the Checkfree/Knight system is to avoid becoming a middleman for payments of individual payees to payors, for the purpose of

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management of risk". The Examiner asserts that the management of risks is more apparent in the first manner in which the bills might be paid but again the Examiner's rejection was based on the third manner in which the bills may be paid and in this third manner the service provider assumes risks of non-payment by having the payees withdraw the payment from the service Provider's account which would be later reimbursed by the consumers. The Examiner wants to point out the title of the Knight reference which reads as follows: "**system and method for electronically providing customer services including payment of bills, financial analysis and loans**".

D. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, since the Examiner has relied her rejection on the third manner in which the bills can be paid(Knight) and clearly the service provider is a middleman between the customer and the various billers. Motivation to modify the Knight's reference with Figure 7 of the Pickering reference which teaches including multiple biller's bills on a single consolidated statement is present in Pickering col. 1, lines 45-49 in which it recognizes that including multiple biller's bills on a single consolidated statement provides the customer or consumer with a convenient, simple and time and money saving bill payment method.

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Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented In this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth In 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Points Of Contact

9. Any inquiry concerning this communications from the examiner should be directed to Raquel Alvarez whose telephone number is (703) 305-0456. The examiner can normally be reached on Monday to Friday from 9:00 AM. To 5:00 PM.

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If any attempt to reach the examiner by telephone is unsuccessful, The examiner's supervisor, James Trammell can be reached on (703) 305-9768. The fax phone number for this group is (703) 305-0040.

R.
A.

Raquel Alvarez
Patent Examiner, AU 2162

January 2, 2001

JAMES P. TRAMMELL
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